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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,808	03/03/2000	Yoji Kawamoto	7217/31035	5769

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EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/13/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

B

# Office Action Summary

Application No.

09/518,808

Applicant(s)

KAWAMOTO ET AL.

Examiner

George C Neurauter

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Objections*

2. Claim 1 is objected to because of the following informalities: Claim recites that the “user specific information” and “information of said terminal device” is transmitted as “the user specific information”. In view of claims 4 and 7, the Examiner will assume the “user specific information” and “information of said terminal device” are together “specific information” transmitted. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
2. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1, 4, and 7 recite “...a predetermined communication system...” There is no mention within the specification of this system and the Examiner does not know the scope of such a system. Therefore, one skilled in the art would not know how to use the invention within this system.

In order to examine the application in light of the prior art, the Examiner will assume the “predetermined communication system” is a communication system as is generally known within the art.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 4, and 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Abraham et al. [US Patent 5 978 568 A].

Regarding claim 1, Abraham discloses a network system connected to a terminal device and a network server via a predetermined communication system, comprising:

means for transmitting user specific information and information of said terminal device used by a user as the user specific information when the user uses said terminal device, wherein said means for transmitting is part of said terminal device; [column 5, lines 12-26; column 5, line 48-column 6, line 60; column 10, lines 15-31]

means for specifying said terminal device being used by said user by memorizing said specific information, wherein said means for specifying is part of said network server [column 5, lines 12-47].

Regarding claim 4, Abraham discloses a terminal device for connection to a network server via a predetermined communication system [column 5, line 48-column 6, line 60], comprising:

means for connecting said terminal device to said network server [column 5, lines 12-26]; and

specific information transmission means for transmitting user specific information and terminal device specific information to said network server as specific information when a user uses said terminal device [column 5, line 48-column 6, line 60; column 10, lines 15-31].

Regarding claim 7, Abraham discloses a network server for connection to a terminal device via a predetermined communication system, comprising:

specific information receiving means for receiving specific information formed of user specific information and user using terminal device specific information transmitted from said terminal device when a user uses said terminal device; memory means for memorizing the specific information received by said specific information receiving means; and specifying means for specifying the terminal device being used by said user based on said specific information of said memory means [column 5, lines 12-47, specifically lines 35-47].

Regarding claim 8, Abraham discloses the network server according to claim 7, wherein said specifying means includes means for transmitting message information to said user of the terminal device by said user specific information based on the specific information of said memory means [column 5, lines 12-47].

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abraham et al. in view of Clark et al. [US Patent 5 892 902 A].

Regarding claim 2, Abraham does not expressly disclose the network system according to claim 1, wherein said terminal device further comprises interface means equipped with memory means in which said user specific information is stored, and said means for transmitting transmits said specific information to said network server when said memory means is loaded, however, Clark does disclose these limitations [column 2, lines 5-47; column 3, line 63-column 4, line 13, specifically column 4, lines 6-12; column 4, lines 59-62].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system as described in Abraham regarding claim 1 with the interface means on a terminal device as described in Clark.

Clark discloses that having a memory means allows authorization of a user on a terminal without unnecessary input from the user and allows for encrypted communications between the terminal device and the network server [column 2, lines 32-47]

Based on the specific advantages described above in Clark regarding the use of a memory means to store user information and wherein a nexus exists between Abraham and Clark exists such that the references are directed towards determining a user's information on a terminal device in order to allow access to data on a network server, one of ordinary skill in the art would have found it obvious to combine the teachings of these references because the use of a memory means to store user information would provide an obvious advantage in terms of portability of the user information.

Therefore, it would have been obvious to achieve the limitations as described in claim 2.

Claim 5 is rejected under 35 USC 103(a) since claim 5 contains the same limitations as recited in claim 2.

8. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abraham et al. and Clark as applied to claims 2 and 5 above, and further in view of Macko et al. [US Patent 5 436 621 A]

Regarding claim 3, Abraham and Clark disclose the network system according to claim 2.

Abraham and Clark do not expressly disclose wherein said means for transmitting transmits information showing completion of a user operation to said network server when said memory means is extracted from said interface means, however, Macko does disclose wherein information is transmitted to a terminal device which shows completion of a user operation when said memory means is extracted from said interface means [column 10, lines 28-67, specifically lines 56-67].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system as described in Abraham and Clark regarding claim 2 with the transmitting of information on the removal of a memory means as described in Macko.

One of ordinary skill in the art would have found it obvious to combine the teachings of these references because memory means are eventually meant to be removed by a user and, even though Abraham or Clark does not expressly disclose doing so, Macko shows that when a memory means is removed, information relating to its removal is sent to notify a processor of the removal. Doing this notification to a network server when the user is done operating the terminal device as disclosed in Abraham and Clark would have clearly been contemplated by one of ordinary skill in the art and the disclosures of Macko clearly illustrate the notification process.

Therefore, it would have been obvious to achieve the limitations as described in claim 3.

Claim 6 is rejected under 35 USC 103(a) since claim 6 contains the same limitations as recited in claim 3.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6 003 136 to Schanze;

US Patent 5 706 427 to Tabuki;

US Patent 5 506 961 to Carlson et al;

US Patent 5 648 929 to Miyamoto;

US Patent 5 537 584 to Miyai et al;

US Patent 5 268 963 to Monroe et al;

US Patent 4 888 773 to Arlington et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C Neurauter whose telephone number is 703-305-4565. The examiner can normally be reached on Mon-Fri 9am-5:30pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

gcn  
December 8, 2002



**DAVID WILEY**  
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